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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,210	03/24/2004	Richard T. Timmer	RUS 3.0-016	3918
45776	7590	03/27/2007	EXAMINER	
DR. REDDY'S LABORATORIES, INC. 200 SOMERSET CORPORATE BLVD SEVENTH FLOOR, BRIDGEWATER, NJ 08807-2862			BALASUBRAMANIAN, VENKATARAMAN	
		ART UNIT	PAPER NUMBER	
				1624
		MAIL DATE	DELIVERY MODE	
		03/27/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action Before the Filing of an Appeal Brief</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/808,210	Timmer et al.	
	Examiner Venkataraman Balasubramanian	Art Unit 1624	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1.  The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a)  The period for reply expires 3 months from the mailing date of the final rejection.  
 b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2.  The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3.  The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

- (a)  They raise new issues that would require further consideration and/or search (see NOTE below);
- (b)  They raise the issue of new matter (see NOTE below);
- (c)  They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d)  They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4.  The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7.  For purposes of appeal, the proposed amendment(s): a)  will not be entered, or b)  will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8.  The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9.  The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10.  The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Advisory Action.

12.  Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_

13.  Other: \_\_\_\_\_.

*Venkataraman Balasubramanian*  
 Venkataraman Balasubramanian  
 Primary Examiner  
 Art Unit: 1624

### **ADVISORY ACTION**

The applicants' request for reconsideration filed 3/05/2007 under 37 CFR 1.116 in reply to the final rejection has been entered. But it is not deemed to place the application in condition for allowance for the following reasons.

Claims 1-3, 5, 14-19, 21, 30-32, 34, 43-45, 47, 56-58, 60, 69-71, 73 and 82-85 are under consideration.

In view of applicants' response, the following 103 rejections made in the previous office action are maintained.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 14-19, 21, 30-32, 34, 43-45, 47, 56-58, 60, 69-71, 73, 81 and 83-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moriarty et al., WO 01/47897 for reasons of record.

This rejection is same as made in the previous office action but now excludes species claim 82. Applicants' argument to overcome this rejection is not persuasive.

Contrary to applicants' urging the genus of instant claims still include compounds of the genus of Moriarty et al. More specifically Zx group of instant claims include V-R<sup>6</sup> choices, R<sup>2a</sup> group of instant claims include Z choices of Moriarty et al., and R<sup>7a</sup> group

of instant claims include R<sup>11</sup> choices of Moriarty et al.

Thus genus of the instant claims read on the genus taught by Moriarty et al.

Applicants had argued that the compounds exemplified by Moriarty et al., does not include the genus of instant compounds. This is not a persuasive argument. Moriarty et al., have adequately exemplified compounds, which will provide guidance to make the genus taught therein and there is requirement that all compounds of the genus should have been exemplified as urged by the applicants. In fact, Moriarty exemplified over 383 compounds which provide adequate guidance for one trained in the art to make these compounds based on the nucleophilic displacement of cyanuric halide with various nucleophiles taught therein.

The fact that Moriarty et al. exemplifies compounds with R<sup>9</sup>=COR<sup>10</sup> wherein R<sup>10</sup> is NHR, does not negate the rest of the teaching of the genus and would not limit Moriarty et al., teachings to species only. Unlike in *In re Baird* where there was no guidance as held by the court, the triazine core and the three substituents on the triazine are clearly taught. One trained in the art is provided with adequate guidance to what to make, how to make and how to use trisubstituted triazines. As for applicants' argument that Moriarty et al., teaching is limited to the preferred embodiments only, applicants' attention is drawn to *In re Bruckel*. Note *In re Bruckel* which states "References must be considered under 35 U.S.C 103, not only for what it expressly teaches but also for what it fairly suggests; all disclosures of prior art, including unpreferred embodiments must be considered in determining obviousness". *In re Bruckel*, 201 USPQ 67.

Furthermore, it should be noted that applicants have not exemplified all compounds of the instant genus but a set of 100 compounds. Based on applicants' own analysis, it would appear that instant genus is also not enabled and that scope of the instant claims to be limited to 100 compounds.

The fact the breadth of the genus is large is not a criteria. It is the objective enablement and teaching of Moriarty et al. clearly provides objective enablement for compounds not exemplified base on that positively exemplified.

Again, if Moriarty et al., is not fully enabled then instant genus is also not fully enabled and would beg 112 first paragraph scope of enablement rejection based on applicants' reasoning that exemplified compounds do no lend enablement for the genus.

The issue at hand is objective enablement. It is held that based on the teachings of 383 exemplified compounds of Moriarty et al., one trained in the art would be able to make and use all compounds of the genus.

Hence, this rejection is proper and is maintained.

Claims 1-3, 5, 14-19, 21, 30-32, 34, 43-45, 47, 56-58, 60, 69-71, 73, 81 and 83-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson et al. WO 01/47921.

This rejection is same as made in the previous office action but now excludes species claim 82. Applicants' argument to overcome this rejection is not persuasive.

Contrary to applicants' urging the genus of instant claims still include compounds of the genus of Erickson et al. More specifically, Zx group of instant claims include R<sup>3</sup>-R<sup>4</sup> (wherein R<sup>3</sup> is H and R<sup>4</sup> is OR<sup>18</sup> R<sup>18</sup> being a hydrocarbon or heteroaryl) choices, R<sup>2a</sup>

group of instant claims include R<sup>1</sup>-N-Y choices of Erickson et al., and R<sup>7a</sup> group of instant claims include R<sup>2</sup>(wherein R<sup>2</sup>=R<sup>7</sup>-R<sup>6</sup>-N-R<sup>5</sup>) choices of Erickson et al.

Thus genus of the instant claims read on the genus taught by Erickson et al. Applicants had argued that the compounds exemplified by Erickson et al., does not include the genus of instant compounds. This is not a persuasive argument. Erickson et al., have adequately exemplified compounds, which will provide guidance to make the genus taught therein and there is requirement that all compounds of the genus should have been exemplified as urged by the applicants. In fact, Erickson exemplified over 164 compounds which provide adequate guidance for one trained in the art to make these compounds based on the nucleophilic displacement of cyanuric halide with various nucleophiles taught therein.

Furthermore, it should be noted that applicants have not exemplified all compounds of the instant genus but a set of 100 compounds. Based on applicants' own analysis, it would appear that instant genus is also not enabled and that scope of the instant claims to be limited to 100 compounds.

As for applicants' argument that the Erickson et al., teaches a "wish list" and "laundry list" is not a persuasive argument as Erickson et al., clearly teaches representative examples of the substituents in the triazine rings. The fact the breadth of the genus is large is not a criteria. It is the objective enablement and teaching of Erickson et al. clearly provides objective enablement for compounds not exemplified base on that positively exemplified.

Again, if Erickson et al., is not fully enabled then instant genus is also not fully

enabled and would beg 112 first paragraph scope of enablement rejection based on applicants' reasoning that exemplified compounds do no lend enablement for the genus.

The issue at hand is objective enablement. It is held that based on the teachings of 164 exemplified compounds of Erickson et al., one trained in the art would be able to make and use all compounds of the genus.

Hence, this rejection is proper and is maintained.

***Allowable Subject Matter***

Species claim 82 is allowed.

***Election/Restrictions***

This application contains claims 4, 6-13, 20, 22, 33, 35-42, 46, 48-55, 59, 61-68, 72 and 74-81 drawn to an invention nonelected with traverse in Paper dated 8/24/2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

**Conclusion**

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Art Unit: 1624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

*Venkataraman Balasubramanian*  
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3/22/2007